

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Helmut Steinhilber et al.
Serial No.: 10/734,442
Date Filed: December 12, 2003
Group Art Unit: 3653
Examiner: Joerger, Kaitlin S.
Title: **METHOD AND DEVICE FOR SELECTING
THE SHEETS OF A RECORD CARRIER
FROM A PILE**

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COMMISSIONER FOR PATENTS
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Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST ARGUMENTS

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal.

Rejections under 35 U.S.C. § 102

Claims 6-10 stand rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by JP 62240237 A filed by Kawamoto Takahiro et al. (“Takahiro”).

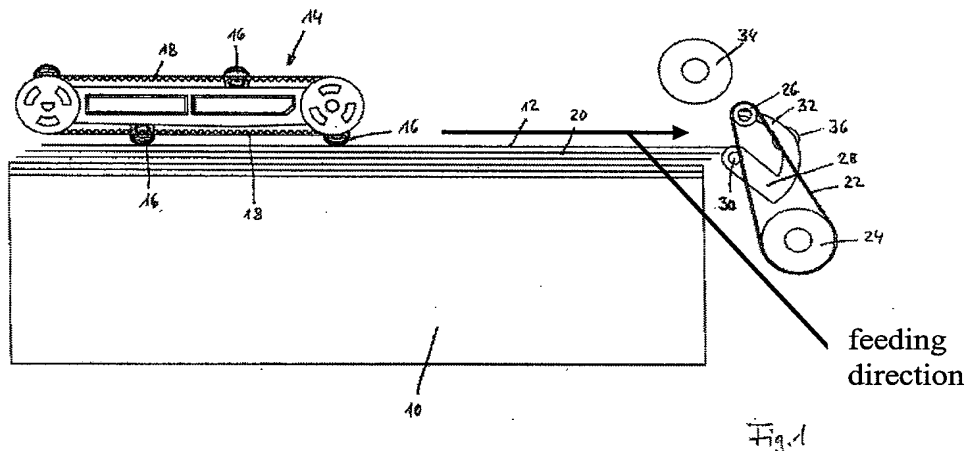
Claim 6 recites “the stop can be moved upwards at an impingement angle of *more than 90 degrees in relation to a flat plane and a direction in which the uppermost sheet is fed.*” (emphasis added). According to the specification,

In order to put this effect to use, the impingement angle of the stop in relation to the flat plane of the fed sheet should be at least 90 degrees. An impingement angle of more than 90 degrees, most advantageously about 100 degrees, or setting the stop in *a slightly tilted position in relation to the pile*, has the advantage that the front edge of the sheet will be maintained contiguous with the stop also when the front edge of the sheet moves upwards in a bow-shaped form.

(Specification, 6:26-7:3) (emphasis added). Further, with reference to Figure 1, the specification teaches,

On the pile 10 there is a rolling action device 14, which corresponds to the rolling action device described, for instance, in DE 100 16 793 A1. This rolling action device 14 has rolling elements that are built as freely revolvable bearing housed turning rollers 16. These turning rollers 16 are embedded onto an endlessly running tractive device 18. The turning rollers 16 are moved in *the feeding direction by the driven tractive device 18, or in the figure, to the right over the uppermost sheet 12 of the pile 10.*

(Specification at 8:21-9:2) (emphasis added).



(Specification at Figure 1) (notations added). Thus, the “flat plane and a direction in which the uppermost sheet is fed” is horizontally to the right in Figure 1.

A premise of the rejection is that Takahiro illustrates that the direction in which the sheet is fed has a vertical component so that the feed direction is inclined approximately 40 degrees from horizontal. (See OA at 3). It should be noted, however, that in the context of the claims and specification of the present invention, the “paper sheet placing unit 17” of Takahiro is the device upon which the pile of paper sits in a horizontal position. The sheets of paper are in the horizontal position when they are engaged by the “drawing belt 12.” Further, when the individual sheets are fed from the pile of paper into the “feed roller 14,” the sheets are horizontal as clearly shown in Figure 2. Thus, the sheets are perfectly horizontal before and after they are engaged by the drawing belt 12. Notwithstanding, in the drawing provided in the Office Action, the feed direction is improperly identified as the direction of

the lifted portion of the top sheet of paper as the edge of the sheet is being lifted by the alleged “stop” (drawing belt 12). The fact that the edge of the paper is lifted during the separation process does not change the defined orientation of the “feed direction.” For example, Figure 2 of the present specification also illustrates that the top sheet of paper is inclined as it is engaged by the stop. But this fact does not change the defined “feed direction” as being horizontally to the right. Thus, the premise of the rejection, which places the “feed direction” in Figure 2 of Takahiro at an incline, is incorrect in the context of the invention as claimed in claim 6 of the present application.

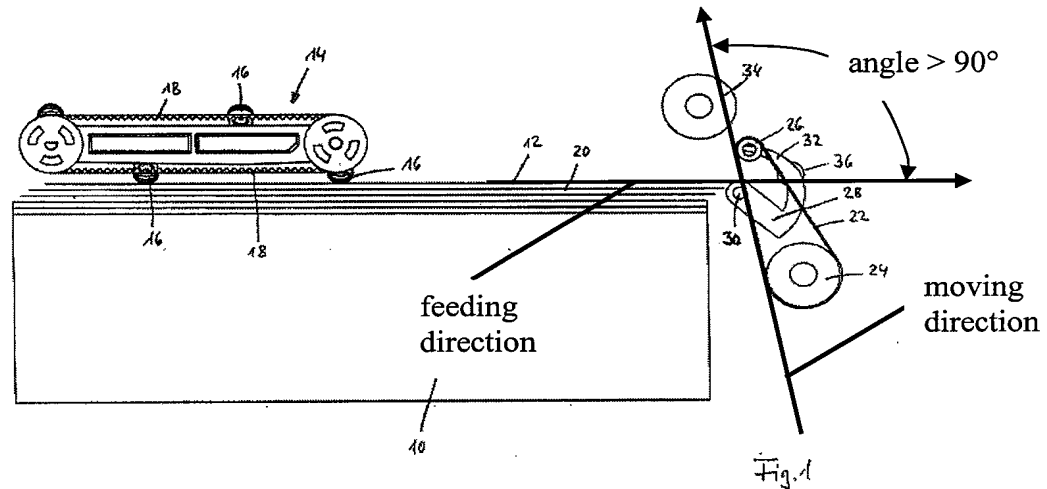
Takahiro fails to teach or suggest the invention as claimed in claim 6 because it shows that the drawing belt 12 is positioned to be 90 degrees relative to the horizontal paper stack.

A fine dislocation is caused among the respective paper sheets in the group of the paper sheets 18 and a larger dislocation is caused at the upper portion by the same force as compared with the lower portion due to the effect of the weight of the respective paper sheets as far as the entire group of the paper sheet 18 is concerned.

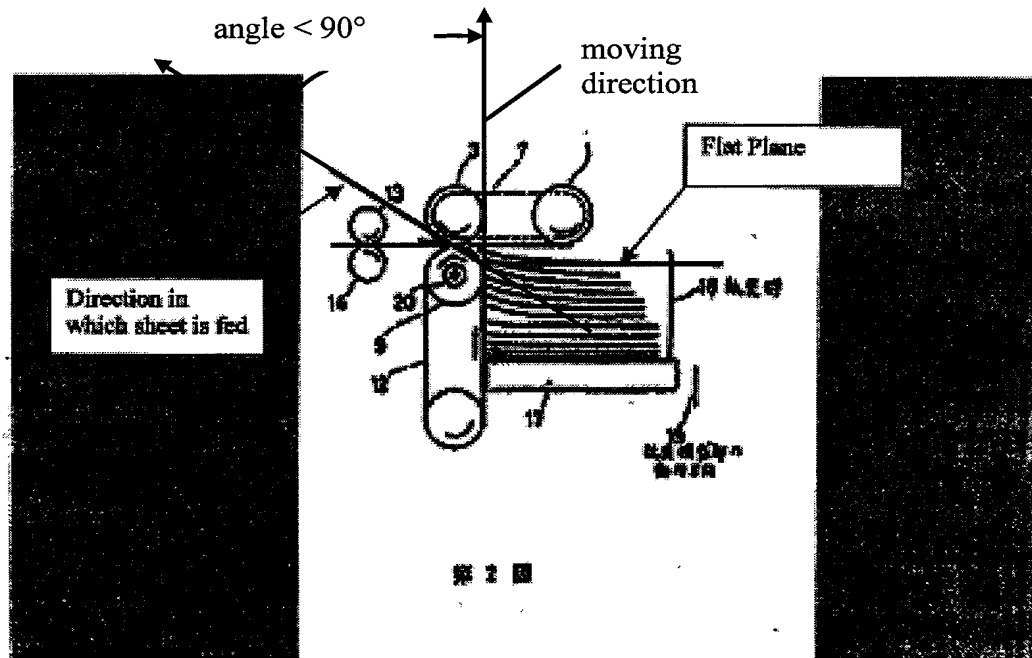
(Takahiro, abstract). Takahiro teaches an impingement angle of 90 degrees so as to apply the same contact force with all of the papers in the paper stack. With the same contact force being applied to the entire stack, only the top paper sheets become dislocated because they are not weighted down by additional paper sheets. According to Takahiro the stack of paper sheets is moved with its front side completely against the drawing belt 12 by the placing unit 17. Only in this way all the paper sheets can be lifted at their front edges by the belt 12 (in a different amount due to the effect of the weight of the papers of the upper part of the stack). Roller 1 does not contact the uppermost sheet of the stack (as can be seen from Figs. 1 and 2 of Takahiro) but drives roller 3. Thus, Takahiro teaches away from an impingement angle of more than 90 degrees. The invention as claimed in claim 6 is patentable in view of Takahiro. The invention of claims 7-10 is patentable for similar reasons.

Further, if the feed direction identified in the Office Action were accepted as correct, a premise with which the applicants do not agree, then the angle between the feed direction and the moving direction of the stop belt would be less than 90°, not greater than 90° as required by the claims. As noted above, claim 6 recites “the stop can be moved upwards at an impingement angle of *more than 90 degrees in relation to a flat plane and a direction in*

which the uppermost sheet is fed." (emphasis added). The relative directions are illustrated with respect to Figure 1.



(Specification at Figure 1) (notations added). Alternatively, if the feeding direction adopted as a premise of the rejection is adopted, the impingement angle is less than 90° as illustrated below.



Therefore, if the feed direction adopted as a premise of rejection were taken as correct, the result is that the impingement angle is less than 90°. Under that interpretation of the claims, the prior art fails to teach all of the claim elements. For this additional reason, the invention as claimed in claim 6 is patentable in view of Takahiro. The invention of claims 7-10 is patentable for similar reasons.

Rejections under 35 U.S.C. §103

Claims 1-3, 5 and 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Takahiro and/or Frost. Similar to the discussion above relative to the invention as claimed in claims 1 and 6, this "feed direction" is the horizontal direction to the right as shown in Figure 1 of the specification. Thus, the invention as claimed in claims 1-3, 5 and 14-17 is patentable in view of Takahiro and Frost.

CONCLUSION

Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicants authorize the Commissioner to charge Deposit Account No. 50-2148 in the amount of \$500.00 for the Notice of Appeal fee and in the amount of \$120.00 for a Petition for One-Month Extension of Time Request.

Applicant believes there are no further fees due at this time; however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2690.

Date: 3/20/07

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Respectfully submitted,
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